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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,017	05/31/2007	David C. Windorski	59529US005	1997

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EXAMINER

SHAH, SAMIR

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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12/02/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/587,017	Applicant(s) WINDORSKI ET AL.	
	Examiner SAMIR SHAH	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 24, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20090915, 20070720, 20070122</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 65 is objected to because of the following informalities: line 4 recites "having" word twice. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 42-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claims 42, 59, 60, 62 and 65 recite the limitation "threshold level". There is insufficient antecedent basis for this limitation in the claim. It is unclear that what threshold means?
5. Claim 46 recites "substantially" in line 2. It is unclear what substantially means
6. Claim 54 recites the limitation "generally linear" and "generally parallel". Given that it is not clear what is meant by "generally" linear or "generally" parallel or how linear or parallel the raised elements would have to be to meet this limitation.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 42, 46, 47, 51-55, and 65-67** are rejected under 35 U.S.C. 102(b) as being anticipated by Inagaki et al. (U.S. 2002/0179237 A1).

9. Regarding claims 42 and 65, Inagaki discloses pressure sensitive adhesive sheet wherein it comprises;

a first substrate having a writeable surface on one side thereof and a mounting surface on a second opposite side thereof (1, figures 3 and 13); and
a pressure sensitive adhesive layer (2, figure 3) exposed on the second side of the first substrate, and a protective material (3, figure 3), e.g. the standoff element, having a height greater than a height of the adhesive, wherein in the absence of a threshold level of pressure applied to the pressure sensitive adhesive layer, the pressure sensitive adhesive is spaced apart from the mounting substrate 4 (Fig 2, paragraph 37) and wherein the sheet is deformable such that a threshold level of pressure applied to the pressure sensitive adhesive layer brings the adhesive into sheet securing engagement with the mount substrate (Fig 3, paragraph 37).

Note that substrate layer, i.e. paper (paragraph 0013), would inherently have a writable front side and opposite side.

10. Regarding claim 46, Inagaki discloses pressure sensitive adhesive sheet wherein upon removal of the sheet from mounting substrate, the pressure layer returns to its original shape (paragraphs 0009 and 0037, figure 4),

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11. Regarding claim 47, Inagaki discloses pressure sensitive adhesive sheet wherein substrate is plastic film (paragraph 0013).

12. Regarding claim 51, Inagaki discloses pressure sensitive adhesive sheet wherein the adhesive is repositional pressure sensitive adhesive (paragraph 0009).

13. Regarding claim 52, Inagaki discloses pressure sensitive adhesive sheet wherein the protective material, e.g. the standoff element, comprises a portion of the first substrate which has a thickness sufficient to space the adhesive exposed on the cover layer from a surface in abutting engagement with the second side of the first substrate, in the absence of a pressure applied to the outer face of the cover layer urging it toward the surface (figure 3).

14. Regarding claim 53, Inagaki discloses pressure sensitive adhesive sheet but fails to disclose that a plurality of said sheets aligned in a stacked orientation fail to adhere together in absent the application of pressure. However, Inagaki's PSA sheet would inherently have this feature since protective material is present on the adhesive layer.

15. Regarding claims 54 and 66, Inagaki discloses pressure sensitive adhesive sheet wherein it comprises mesh form protective material (paragraph 0036), i.e. linear raised element, on a side of substrate wherein mesh is made of multiple parallel strips and at least a portion of the pressure sensitive adhesive on the same side of the substrate and substrate has a height lower than the mesh form protective material (figures 1 and 3).

16. Regarding claim 55, Inagaki discloses pressure sensitive adhesive sheet wherein the raised element is continuous strips (figure 3).

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17. Regarding claim 67, Inagaki discloses pressure sensitive adhesive sheet wherein it is securing engagement with a mounting surface (figures 2 and 3).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

a. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. **Claims 43-45 and 48-50** are rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. (U.S. 2002/0179237 A1) in view of Chase (U.S. 3517106).

20. Inagaki discloses pressure sensitive adhesive sheet as described above. Regarding claims 43, 44, and 48, Inagaki fails to meet the limitation of present claims.

21. Chase teaches methods and materials for mounting illustrations, clippings, pictures and the like in accurate position on mounting boards, picture-album pages, and like supports (Column 1, lines 13-16). With respect to claims 43 and 48, Chase teaches a thin paper web coated with pressure sensitive adhesive layer on both surfaces of the paper web wherein the pressure sensitive adhesive layer is covered with a paper release sheet on both sides of the pressure sensitive adhesive layers (Column 1, lines 16-17, Column 4, lines 71-75, Column 5, lines 1-2). Further, Figure 1 and Figure 2 of Chase shows a paper web W coated on both sides with the pressure sensitive adhesive A and a release sheet that is made of easily separable sections IR and ER. The

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removal of one section of the release sheet as shown in Figure 1 exposes the pressure sensitive adhesive layer A as indicated by CA. The paper release sheet as shown in Figures 1 and 2 of Chase reads on the claimed paper layer wherein a portion of the paper layer having an upper edge with a portion of the paper layer being removed to define a paperless zone which includes a gap across the upper edge as claimed in the claims 43 and 48. Further, the pressure sensitive adhesive coated paper web W (Figures 1 and 2) of Chase reads on the cover layer having pressure sensitive adhesive disposed on its inner face where the cover layer adhered thereby to the front side of the paper layer to cover the paperless zone in an alignment where a top edge of the cover layer extends across the gap of the paperless zone and the adhesive on the inner face of the cover layer is exposed across the paperless zone on the back side of the paper layer. Note that the paper based release sheet intrinsically has a writable front side and an opposite side.

22. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the structure of Chase in the sheet of Inagaki so that it functions same as chase invention.

23. Regarding claim 49, Inagaki fails to meet the limitation of present claim.

24. Chase at Column 1 lines 35-46 and Figure 10 teaches that if it is desired to secure a picture to a support such as an album page, a mount with adhesive on both surfaces is used, and after the picture is adhered to the mount a section of the release sheet on the other side of the mount is removed and the composite picture and mount is arranged on the support so only the remainder of the release sheet touches the mount

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and the composite picture and mount is accurately located and held in position while the exposed adhesive is pressed into adhering contact with the support thereby fixing the position of the picture on the support. Further note that the pressure sensitive adhesive coated web W is thin and made of paper (Column 4, line 71) thus the web W is inherently flexible. The examiner is equating the album page of Chase as the claimed surface as claimed in the claim 49.

25. It would have been obvious to one of ordinary skill in the art at the time of the invention to use structure of chase invention in the sheet of Inagaki to have some flexibility.

26. Regarding claim 45, Inagaki discloses pressure sensitive adhesive sheet wherein the outer most surface, e.g. second substrate, has indicia on it (paragraph 0007).

27. Regarding claim 50, Inagaki discloses pressure sensitive adhesive wherein indicia would intrinsically have a color.

28. **Claims 56-60** are rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. (U.S. 2002/0179237 A1) in view of Sommers (U.S. 5924227).

29. Inagaki discloses pressure sensitive adhesive sheet as described above.

Regarding claims 56-58, Inagaki fails to meet the limitation of present claims.

30. Sommers discloses an index card wherein a score line on the substrate which is placed from and parallel to the upper edge of the substrate and a cut formed through the substrate, the cut extending from a first end on the score line toward the upper edge to a first turn, extending from the first turn along and spaced from the upper to a second

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turn, and then extending from the second turn away from the upper edge to a second end of the cut on the score line (figures 2 and 3).

31. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the folding mechanism of Sommers with the sheet structure of Inagaki so that it is easy to view and handle.

32. Regarding claims 59-60, Inagaki discloses pressure sensitive adhesive sheet wherein it comprises pressure sensitive adhesive (paragraph 0037). Inagaki alone fails to meet all the limitation as present claims.

33. Sommers discloses an index card wherein the spacing portion of the substrate being folded over so that it lean towards the second side of the substrate, thereby forming a raised layer on the second side of the substrate which defines the standoff element and which has a higher thickness than the substrate (figures 2 and 3).

34. It would have been obvious to one of ordinary skill in the art at the time of the invention to put pressure sensitive adhesive of Inagaki on the folded portion to have better adhesion than just folding.

35. **Claim 61** is rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. (U.S. 2002/0179237 A1) in view of Kanki et al (U.S. 5824415).

36. Inagaki discloses pressure sensitive adhesive sheet as described above.

Regarding claim 61, Inagaki fails to meet the limitation of present claim.

37. Kanki discloses decorative material sheet wherein it comprises varnish, i.e. masking material, to improve the adhesion between the layers (column 6, lines 27-34).

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38. It would have been obvious to one of ordinary skill in the art at the time of the invention to use varnish material of Kanki on the adhesive layer of Inagaki to the adhesion between the adhesive layer and the standoff element.

39. **Claims 62-64** are rejected under 35 U.S.C. 103(a) as being unpatentable over Inagaki et al. (U.S. 2002/0179237 A1) in view of Calhoun et al. (U.S. 5141790).

40. Inagaki discloses pressure sensitive adhesive sheet as described above. Regarding claims 62-64, Inagaki fails to meet the limitation of present claims.

41. Calhoun discloses repositionable pressure sensitive adhesive tape wherein a recess formed on the second side of the first substrate, the first side of the first substrate having no surface discontinuities relative to the recess, and the adhesive on the second side of the first substrate is disposed only within the recess, the recess having a depth, relative to an unrecessed portion of the second side of the first substrate, which is sufficient to space the adhesive from the mounting substrate and the first substrate has an upper edge and wherein the recess has an upper border which extends along and is spaced from the upper edge of the first substrate and the first substrate has first and second side edges, and wherein the recess extends the first substrate from first side edge to the second side edge thereof (col.5, lines 19-40 and figure 1).

42. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the structure of tape of Calhoun in the sheet of Inagaki to protective the

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adhesive and so that the sheets do not get stuck with each other in absent of pressure when they are stacked on one another.

43. **Claims 42-44 and 48-49** are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Chase (U.S. 3517106) in view of Inagaki et al. (U.S. 2002/0179237 A1).

44. Regarding claims 42-44 and 48-49, Chase teaches methods and materials for mounting illustrations, clippings, pictures and the like in accurate position on mounting boards, picture-album pages, and like supports (Column 1, lines 13-16). With respect to claims 43 and 48, Chase teaches a thin paper web coated with pressure sensitive adhesive layer on both surfaces of the paper web wherein the pressure sensitive adhesive layer is covered with a paper release sheet on both sides of the pressure sensitive adhesive layers (Column 1, lines 16-17, Column 4, lines 71-75, Column 5, lines 1-2). Further, Figure 1 and Figure 2 of Chase shows a paper web W coated on both sides with the pressure sensitive adhesive A and a release sheet that is made of easily separable sections IR and ER. The removal of one section of the release sheet as shown in Figure 1 exposes the pressure sensitive adhesive layer A as indicated by CA. The paper release sheet as shown in Figures 1 and 2 of Chase reads on the claimed paper layer wherein a portion of the paper layer having an upper edge with a portion of the paper layer being removed to define a paperless zone which includes a gap across the upper edge as claimed in the claims 43 and 48. Further, the pressure sensitive adhesive coated paper web W (Figures 1 and 2) of Chase reads on the cover

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layer having pressure sensitive adhesive disposed on its inner face where the cover layer adhered thereby to the front side of the paper layer to cover the paperless zone in an alignment where a top edge of the cover layer extends across the gap of the paperless zone and the adhesive on the inner face of the cover layer is exposed across the paperless zone on the back side of the paper layer. Note that the paper based release sheet intrinsically has a writable front side and an opposite side. Regarding claim 49, Chase at column 1 lines 35-46 and Figure 10 teaches that if it is desired to secure a picture to a support such as an album page, a mount with adhesive on both surfaces is used, and after the picture is adhered to the mount a section of the release sheet on the other side of the mount is removed and the composite picture and mount is arranged on the support so only the remainder of the release sheet touches the mount and the composite picture and mount is accurately located and held in position while the exposed adhesive is pressed into adhering contact with the support thereby fixing the position of the picture on the support. Further note that the pressure sensitive adhesive coated web W is thin and made of paper (Column 4, line 71) thus the web W is inherently flexible. The examiner is equating the album page of Chase as the claimed surface as claimed in the claim 49.

45. Chase fails to teach standoff element.

46. Inagaki discloses pressure sensitive adhesive sheet wherein it comprises;
a first substrate having a writeable surface on one side thereof and a mounting surface on a second opposite side thereof (1, figures 3 and 13); and a pressure sensitive adhesive layer (2, figure 3) exposed on the second side of the first

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substrate, and a protective material (3, figure 3), e.g. the standoff element, having a height greater than a height of the adhesive, wherein in the absence of a threshold level of pressure applied to the pressure sensitive adhesive layer, the pressure sensitive adhesive is spaced apart from the mounting substrate 4 (Fig 2, paragraph 37) and wherein the sheet is deformable such that a threshold level of pressure applied to the pressure sensitive adhesive layer brings the adhesive into sheet securing engagement with the mount substrate (Fig 3, paragraph 37).

47. It would have been obvious to one of ordinary skill in the art at the time of the invention to use standoff element of Inagaki in the cards of Chase so that cards do not get stuck to each other when they are stacked on one another.

Conclusion

48. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. GB 1053292, US 5318825, and US 5522622 discloses a general idea of a paper product sheet having repositionable adhesive but fails to disclose standoff element and different aspects of present invention.

49. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMIR SHAH whose telephone number is (571)270-1143. The examiner can normally be reached on 8am to 5pm.

50. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571)272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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51. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S.S./

SAMIR SHAH

Examiner, Art Unit 1794

November 19, 2009

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794